

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

DAHIYAT *et al.*

Serial No. 09/927,790

Filed: August 10, 2001

For: *Protein Design Automation for
Protein Libraries*

Examiner: BORIN, Michael L.

Art Unit: 1631 Conf. No.: 6955

Electronically filed

TERMINAL DISCLAIMER TO
OBVIATE A DOUBLE PATENTING REJECTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **Xencor, Inc.** (hereinafter "Xencor"), represents that it is the assignee of the entire right, title, and interest of:

1. The instant application, U.S. Serial No. 09/927,790, filed August 10, 2001, which is a Continuation-in-Part of U.S. Application Serial No. 09/782,004, filed February 12, 2001, Pending, which is a Continuation of U.S. Application Serial No. 09/419,351, filed October 15, 1999, now issued as U.S. Patent No. 6403312 on June 11, 2002; and
2. U.S. Serial No. 10/666,311, filed September 18, 2003, pending; which is a divisional of U.S.S.N. 09/782,004, filed February 12, 2001, pending;
3. U.S. Serial No. 10/218,102, filed August 12, 2002, pending, which is a continuation of 09/927,790, filed August 10, 2001, pending.

An assignment is recorded in the United States Patent and Trademark Office for U.S. Serial No. U.S. Serial No. 09/782,004, filed February 12, 2001, at Reel No. 012070, Frame No. 0692, on August 13, 2001.

An assignment is recorded in the United States Patent and Trademark Office for U.S. Serial No. U.S. Serial No. 10/218,102, filed August 12, 2002, at Reel No. 013528, Frame No. 0271, on January 25, 2002.

Xencor hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of U.S. Serial No. 10/666,311, filed September 18, 2003; and

Xencor hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of U.S. Serial No. 10/218,102, filed August 12, 2002.

Xencor hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Xencor does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Serial No. 10/218,102, filed August 12, 2002, and U.S. Serial No. 10/666,311, filed September 18, 2003, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by

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a reexamination certificate, is issued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee Xencor.

Also included herewith is the terminal disclaimer fee of \$65.00 under 37 C.F.R. 1.20(d). While Applicants believe that no other fees are due at this time, the Commissioner is authorized to charge any fees, including extension fees or any other relief that may be required, in connection with this reply to Deposit Account 50-0310 (Docket No.: 67461-5041-US02).

The undersigned is an attorney or agent of record.

CERTIFICATE OF ELECTRONIC TRANSMISSION UNDER 37 C.F.R. 1.6(a)(4)
I hereby certify that this correspondence, including listed enclosures, is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office on:

Dated: February 22, 2007

Signed: Michael Paulsen 1

MORGAN, LEWIS & BOCKIUS LLP

Dated: February 22, 2007

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Filed Under 37 C.F.R. 1.34